10/784,626   00AB070A/ALBRP175USA

REMARKS

Claims 1, 2, 4-13 and 15-21 are currently pending in the subject application and are presently under consideration. The Examiner's indication that claim 18 would be allowed if recast in independent form to include limitations of the respective base and intervening claims is appreciated. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   Rejection of Claims 1-2, 4-5 and 7-9Under 35 U.S.C. §102(e)

Claims 1-2, 4-5, 7-10, 15-17 and 19-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Parker *et al.* (U.S. 6, 112, 312). This rejection should be withdrawn for at least the following reasons.

> A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention generally relates to test systems and in particular to a test executive software system and a method for developing tests to verify the functionality of industrial control modules. To this end, independent claim 1 describes a system that tests industrial control modules, wherein an: *instrument component is a dynamically linked library that can be broken into basic functional modules associated with the particular instrument type wherein obsolete instruments can be removed or replaced by editing the dynamically linked library.*

Parker *et al.* relates to a method for generating functional tests for a microprocessor having several operating modes and features. As conceded by the Examiner Parker et al. does not disclose removing or replacing obsolete instruments by

6

editing the DLL. In view of at least the foregoing this rejection with respect to the independent claim 1 and all the claims that depend there from should be withdrawn.

II. Rejection of Claims 10, 15-17 and 19-21 Under 35 U.S.C. §102(e)

Claims 10, 15-17 and 19-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Parker *et al.* (U.S. 6,112,312). This rejection should be withdrawn for at least the following reasons. Parker *et al.* fails to teach or suggest *each and every element* of the subject claims.

As stated *supra*, the claimed invention generally relates to test systems and in particular to a test executive software system and a method for developing tests to verify the functionality of industrial control modules. To this end, independent claims 10 and 20 recite similar features namely, *means for verifying if the at least one test template file operates properly and means for testing the industrial control module with the verified test template file.* The tests upon being compiled and linked are then run in a virtual mode for debugging. Only upon debugging and verification, are the tests run in live mode.

According to Parker et al. functional tests include software instructions to a microprocessor to perform certain tasks. The end result of the instructions is compared to the functional specification of the microprocessor. The test is considered a failure if the result is different. In this situation Parker et al. cites only microprocessor design/manufacturing flaws as reasons for such test failures (Column 2 lines 2 – 4, Column 11 lines 7 - 10). But nowhere does Parker *et al.* teach that there could be bugs in the test file let alone suggesting debugging the test file. On page 9 of the Final Office Action dated 24 January '06, the Examiner contends that since the model of the microprocessor can only be implemented in software, the simulated test of Parker *et al.* is evaluation of the actual test file. Parker *et al.* only teaches the use of a microprocessor model in the simulation system for functional verification of the microprocessor design before prototypes are manufactured and not for the verification of the software instructions given to the microprocessor model (Column 2 lines 43 – 53, Column 3 lines 2 - 10). Therefore it is submitted that Parker et al. is silent with respect to *verifying if the*

7

at least one test template file operates properly and testing the industrial control module with the verifying test template file.

In view of at least the foregoing it is clear that an identical invention in as complete detail as disclosed in the subject claims is not taught by the cited reference. Hence this rejection should be withdrawn with respect to independent claims 10 and 20 and all the claims that depend there from.

III.   Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Parker *et al.* in view of *Microsoft Computer Dictionary* (Microsoft). It is respectfully requested that this rejection should be withdrawn for at least the following reasons. Claim 6 depends from independent claim 1. In view of at least the aforementioned arguments with respect to independent claim 1, it is respectfully requested that this rejection be withdrawn with respect to dependent claim 6.

IV.   Rejection of Claims 11-13 Under 35 U.S.C. §103(a)

Claims 11-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Parker *et al.* in view of *Microsoft Computer Dictionary* (Microsoft). It is respectfully requested that this rejection should be withdrawn for at least the following reasons. Microsoft does not make up for the aforementioned deficiencies of Parker *et al.* with respect to independent claim 10 (from which the claims 11 - 13 depend). Specifically Microsoft fails to teach or suggest a method for testing industrial control modules comprising the step of *determining if the at least one test template file operates properly.* Therefore, the subject invention as recited in independent claim 10 (from which the claims 11 - 13 depend) is not obvious over the combination of Parker *et al.* and Microsoft. Thus it is respectfully requested that this rejection be withdrawn.
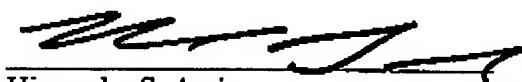
8

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBRP175USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP

Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731

9